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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/045,789 | 01/11/2002 | Rainer Sommer | 10191/2209 | 3038 |
| 26646 | 7590 | 01/13/2005 | EXAMINER | |
| KENYON & KENYON ONE BROADWAY NEW YORK, NY. 10004 | | | BROADHEAD, BRIAN J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3661 | |

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,789

Applicant(s)

SOMMER, RAINER

Examiner

Brian J. Broadhead

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on 10-13-04, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2):

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 through 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite the limitations of direct selection of control parameters and indirect selection of control parameters by algorithmic processing of a plurality of bit positions but the specification does not make the difference clear. For direct selection

the specification states that one bit position is mapped to a memory location(or locations) in the code memory, but in the case of indirect selection multiple bit positions are used to find a location in code memory. How is that direct versus indirect algorithmic processing? Both ways of selection state that for a bit or bits combination look to a specific a memory location or locations.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volkswagen official factory repair manual for model year 1999 Jetta/Golf/GTI, in view of Gormley, 5513107.

6. Volkswagen discloses means for indirect selection of control parameters from the means for storing control parameters by algorithmic processing of values of a plurality of bit positions of the version coding on page 1-29 through page 1-32; direct selection of control parameters from the means for storing control parameters as a function of individual bit positions of the version coding on page 1-32; the means for selection is adapted to read control parameters which are contained in the version coding on page 1-32; and means for reading control parameters contained in the version coding on page 1-32. Volkswagen does not disclose means for storing a plurality of control parameters for the different vehicle version; means for storing a version coding for

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customizing the vehicle controller for a predetermined vehicle version, the version coding having a plurality of bit positions; and the control parameters pertain to values of an electric unit. Gormley teaches means for storing a plurality of control parameters for the different vehicle version on lines 5-7, on column 7; means for storing a version coding for customizing the vehicle controller for a predetermined vehicle version, the version coding having a plurality of bit positions on lines 37-48, on column 4; and the control parameters pertain to values of an electric unit on lines 7-18, on column 5. It

would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Gormley in the invention of Volkswagen because the while Volkswagen discloses adapting the controller to a version of a car Volkswagen does not disclose how the controller will know how to communicate and process the information from the systems in that version of the car. Gormley provides a way to provide that information. For example, the coding in Volkswagen allows specification that there is a brake pad sensor, a seatbelt warning, and a washer fluid level on page 1-32, and then on page 1-6, Volkswagen discloses that the sensors that are available are monitored and DTC can be stored when there are errors. There needs to be some programming or control parameters that are activated when the controller is coded for a vehicle with a brake pad sensor, a seatbelt warning, and a washer fluid level that tells the controller how to interact with this equipment.

7. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volkswagen official factory repair manual for model year 1999 Jetta/Golf/GTI, in view of

Gormley, 5513107, as applied to claims 1, 5, 7, and 11 above, and further in view of Becker et al., 6184661.

8. Volkswagen and Gormley disclose the limitations as set forth above. They do not disclose the electric unit is a generator. Becker et al. teach of a parameter map for an alternator on lines 19-25, on column 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the control parameter setting of Volkswagen and Gormley with the teachings of Becker because such

modification would allow the configuration of operating subsystems as disclosed in Gormley. Gormley discloses setting parameters for various subsystems in a vehicle and lists several examples. While an alternator or generator is not specifically cited one of ordinary skill in the art would know that any subsystem that has parameters that can be set could be set with Gormley.

Response to Arguments

9. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection. In response to the arguments that the Manual does not disclose storing a code for customizing a vehicle controller I will provide a summary of what the Manual does disclose. The instructions on page 1-29 are instruction for the diagnostic system of the vehicle, however the table included and the codes it provides are also necessary when replacing the instrument cluster in the vehicle. The OBD system is the way that controllers in the vehicle are accessed by a scan tool and through this scan tool coding is set. Measuring blocks for diagnostic functions can also be accessed. If you read on page 1-6, the manual discloses that the

instrument cluster includes a microprocessor(controller) that includes OBD capability for monitoring sensors and components in the vehicle. On page 1-7, it is disclosed that replacement instrument clusters need to be coded according to vehicle market versions and equipment levels. This would have also been done at the factory with the original vehicle instrument cluster.

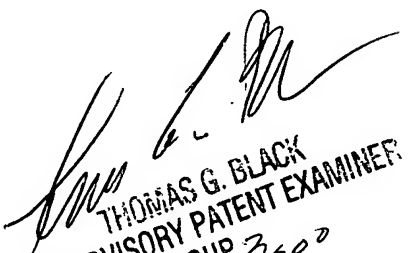
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Broadhead whose telephone number is 703-308-9033. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


BJB


THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
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